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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/715,073
Filing Date: November 20, 2000
Appellant(s): CANTONIS, JAMES M.

James C. Wray
For Appellant

EXAMINER'S ANSWER

MAILED

OCT 04 2004

GROUP 1700

This is in response to the appeal brief filed 04 August 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-58 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

4821360	GIALLOURAKIS	04-1989
3083392	SEWELL	04-1963
5918341	HALE	07-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-9, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin et al., USPN 5,671,498. (This rejection is set forth in a prior Office Action, mailed on 04 May 2004.) Martin et al. discloses a scrubbing device that is an elongated wringable pad comprising a cover (14) and absorbent material (12; Figure 1), at least one rectangular piece forming the cover (Column 5 Lines 64-66; see also Figures 1 and 2, that the stitching indicates that the pieces are rectangular to form the assembly), plural holes within the piece (Column 5 Lines 44-47), and the pad of a sufficient length to wring, the holes are spaced on one-half inch centers (Column 5 line 46 discloses a hole size of 1/16 of an inch and therefore every eighth hole is one half inch interval from another), the absorbent material may be a poly sponge (Column 5 Lines 52-53), the at least one rectangular piece is two rectangular sheets (Column 3 Lines 52- 54) which has two opposite end edges and side edges (a rectangle must have opposite end edges and side edges), and a pocket formed by joints that are stitches (Column 6 Lines 17-

25). Martin et al. does not disclose a physical dimension for the scrubbing device.

Martin et al. does however provide a teaching that the device may extend for a length to enable a human user to cleanse the back (Figure 19 shows a length of at least three times greater than a width, and Column 9 Lines 41-60.)

Claims 39-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Giallourakis, USPN 4,821,360. (This rejection is set forth in a prior Office Action, mailed on 04 May 2004.) Giallourakis discloses a polishing pad that comprises a cover that encloses an absorbent material (Figure 3 (2)), the cover further comprising first and second side portions (where the label (12) is located in Figure 2 is one side and there being an opposite side portion (where the label (8) is located in Figure 2), top and bottom portions (Figure 1), and first and second opposite end portions (shown in Figure 4, one end portion near the label (13)) having a complementary shape for fitting within the cover, and the cover having a plurality of openings (Figure 5). The openings are disposed on the top, bottom, sides, and ends of the cover (Column 3 Lines 35-40) as the fabric with the openings is used for the entire cover. The cover further comprises connections that are seams (Figure 2 (12), (14), (18)) that can be turned inside out as shown in Figure 3 to have inside seams for a smooth outer surface. The connections are on both or either side portion, the top and bottom portions, and one end portion (Figures 2 and 3). The other end portion "seam" comprises of an elastic member (Figure 4 (13)) that joins the end portion to the side portion, top portion, and bottom portion and forms a smooth outer surface. In addition, the pad cover is formed of at least one rectangular piece (Column 2 Lines 38-41), plural holes in that piece (Figure 5),

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the pad being of a sufficient length to wring, the absorbent material is an elongated poly sponge (Column 2 Lines 12-13), wherein the at least one rectangular piece is an at least one rectangular sheet (Column 3 Lines 10-13 and Lines 36-38), the at least one rectangular sheet having has two opposite end edges and side edges (a rectangle must have opposite end edges and side edges), a pocket formed by joints along the edges (Column 3 Lines 24-26), the joints being seams formed by stitches (Column 3 Lines 18-20), the pocket has the seams inward facing and smooth outer surfaces (Column 2 Lines 28-30 provide that it can be sown but turned inside out so that the smooth surface is the outer surface), at least one rectangular sheet has folds medially between the end edges about an axis forming a pocket having equal halves joined along the side edges (Figures 1A and 2A), plural pieces form the cover (Column 2 Lines 38-41), and the cover completely encloses the absorbent material and edges are jointed to prevent the absorbent from slipping out (Figure 4 and Column 3 Line 52 to Column 4 Line 4).

Further, the plural pieces are at least four rectangular pieces (Column 3 Lines 35-40 disclose that each of two sheets may have a double layer of material, which is a total of four sheets), connections for the four sheets being stitched seams in alignment along the two longer parallel side edges and end edge comprising a pocket (Column 3 Lines 40-46; Figure 2), where the pocket has the seams inward facing and smooth outer surfaces (Column 2 Lines 28-30 provide that it can be sown but turned inside out so that the smooth surface is the outer surface), the absorbent material to be inserted is an elongated poly sponge (Column 2 Lines 12-13), and the sheets are formed by connections prior to the insertion of the absorbent material (Column 3 Lines 48-51).

Even further, Giallourakis discloses that an at least one rectangular sheet that has opposite end-edges and side-edges has a fold between the end edges about a medial axis forming a pocket having the adjacent edges joined to each other (Column 3 Lines 10-13, Lines 27-31; Figures 1 A and 2A).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-9, 17-19, and 21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sewell, USPN 3,083,392. (This rejection is set forth in a prior Office Action, mailed on 04 May 2004.) Sewell discloses a combination sponge and chamois that is an elongated (Figures 1, 2, or 3) wringable pad that has a chamois cover (Figure 1 (3), Figure 2 (7), and Figure 3 (13)), at least one rectangular piece forming the cover (Figures 1-3), plural holes in the piece (Figure 1 (4); Figure 2 (11); Figure 3 (15)), the pad of a sufficient length to wring, an artificial sponge (which would include poly) (Figure 1 (2); Figure 2 (6); Figure 3 (12)), the at least one rectangular piece is an at least one rectangular sheet which has two opposite end edges and side edges (a rectangle must have opposite end edges and side edges), a pocket is formed by joints along the edges for receiving and holding the absorbent material, where the joints are formed by stitches (Column 2 Lines 22-23), and plural chamois (also man-made chamois-like) pieces may form the cover

(Figures 2 and 3). The length and width is not specifically disclosed, however it appears in Figure 1 that the length is approximately three times greater than the width. It would have been obvious to one of ordinary skill in the art to modify the width or length of Sewell to provide the user with a sponge that can be gripped easily or to ergonomically clean narrow areas.

Claims 1, 5-11, 13, 14, 18, 22-23, 27-38, 57, and 58 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Giallourakis, USPN 4,821,360. (This rejection is set forth in a prior Office Action, mailed on 04 May 2004.) Giallourakis discloses all elements above however does not disclose the specific length and width although it appears in Figures 3 and 4 that the length is approximately three times greater than the width. It would have been obvious to one of ordinary skill in the art to modify the width or length of Giallourakis to provide the user with a sponge that can be gripped easily or to ergonomically clean narrow areas.

Claim 16 is rejected under 35 U.S.C. 103(a) as obvious over Sewell, USPN 3,083,392. (This rejection is set forth in a prior Office Action, mailed on 04 May 2004.) Sewell does not more specifically recite that the length of the cover is about eighteen and three-quarter inches and a width is about twelve and one-half inches. It would have been obvious for one of ordinary skill in the art to modify Sewell so that the cover has dimensions that the length of the cover is about eighteen and three-quarter inches and a width is about twelve and one-half inches as to be an appropriate dimension for specific cleaning purposes.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giallourakis, USPN 4,821,360. (This rejection is set forth in a prior Office Action, mailed on 04 May 2004.) Giallourakis discloses all elements mentioned above, however does not disclose that the fold is made medially between the side-edges. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to make a medial fold along the side-edges instead of the end-edges because Appellant has not disclosed that folding the material along particular edges provides an advantage is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art furthermore, would have expected Appellant's invention to perform equally as well with the fold medially along the side edges because it will still form a pocket with three sides with stitched joints. Therefore it would have been obvious for one of ordinary skill in the art to modify '360 to obtain the invention as specified in claims 12 and 14.

Claim 15 is rejected under 35 U.S.C. 103(a) as obvious over Martin et al., USPN 5,671,498. (This rejection is set forth in a prior Office Action, mailed on 04 May 2004.) Martin et al. disclose all elements above including a teaching that the device may be used with an additional holder to be further elongated in order to clean a user's back. With this use, the length of the cover could be *about* 37 1/4" and the width is *about* 6 1/4" since those are suitable dimensions for cleaning a human back. It would have been obvious for one of ordinary skill in the art to modify Martin et al. so that the cover has a length of about 37 1/4" and the width is about 6 1/4" as to be an appropriate dimension for specific cleaning purposes, such as a human back.

Claim 16 is rejected under 35 U.S.C. 103(a) as obvious over Giallourakis, USPN 4,821,360. (This rejection is set forth in a prior Office Action, mailed on 04 May 2004.) Giallourakis does not more specifically recite that the length of the cover is about eighteen and three-quarter inches and a width is about twelve and one-half inches. It would have been obvious for one of ordinary skill in the art to modify Giallourakis so that the cover has dimensions that the length of the cover is about eighteen and three-quarter inches and a width is about twelve and one-half inches as to be an appropriate dimension for specific cleaning purposes.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sewell, USPN 3,083,392. (This rejection is set forth in a prior Office Action, mailed on 04 May 2004.) Sewell discloses all elements mentioned above including the cover material being chamois, however does not disclose a sheep-skin chamois. It would have been obvious to one of ordinary skill at the time of the invention was made to use sheep-skin chamois as a specific chamois cover material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering choice. In re Leshin, 125 USPQ 416.

Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giallourakis, USPN 4,821,360 in view of Hale, USPN 5,918,341. (This rejection is set forth in a prior Office Action, mailed on 04 May 2004.) Giallourakis discloses all elements mentioned above, however does not disclose a specific length or width dimension. Hale discloses a hand-sized controlled-fold cleaning sleeve that provides

the teaching for a hand held wiping or cleaning device, the approximate size required would be 4 inches wide by 9 inches long (Column 3 Lines 27-32). It would have been obvious to one of ordinary skill in the art to modify the size of the pad disclosed by Giallourakis and to use pieces of *about* 9 ½" in length and *about* 6 ¼" in width as Hale teaches to make the pad an appropriate and ergonomic size to be hand held.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giallourakis, USPN 4,821,360 in view of Sewell, USPN 3,083,392. (This rejection is set forth in a prior Office Action, mailed on 04 May 2004.) Giallourakis discloses all elements mentioned above, however does not disclose a using a chamois material. Giallourakis however does disclose that it is desirable to use a soft nonabrasive fabric (Column 1 Lines 13-14.) Sewell discloses a chamois cover (Column 1 Lines 13-16.) It would have been obvious to one of ordinary skill at the time of the invention was made to use chamois, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering choice. In re Leshin, 125 USPQ 416.

(11) Response to Argument

The Appellant's first argument is in regards to the rejection of Martin to independent **claim 1**, and how Martin provides a skin exfoliating scrubbing device and that Martin's pad is "squeezable and that essentially teaches away from the claimed wringable pad." In response to appellant's argument that Martin's pad is "squeezable" and not "wringable" as the claimed invention discloses, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed

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invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Further, it is unclear to the Examiner how a pad being "squeezable" would *teach away* from a "wringable" pad. Wring is defined as "To twist, squeeze, or compress, especially so as to extract liquid" according to "*The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2000 by Houghton Mifflin Company.*" Clearly, since to wring also means to squeeze, it is clear that Martin's pad is wringable. In response to appellant's argument that Martin has nothing to do with the appellant's invention since it is abrasive, it is noted that the features upon which appellant relies (i.e., non-abrasive cover) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Next, the Appellant contends that Martin does not describe or teach at least one rectangular piece forming the cover. Martin *does* in fact describe and teach at least one rectangular piece forming the cover. See Column 5 Lines 64-66, Figures 1 and 2, that the stitching further indicates that the pieces are rectangular to form the assembled product. Also contrary to the Appellant's position, Martin does describe an elongated wringable pad (10) that has an absorbent material enclosed within a cover (14) and the cover having holes ("mesh openings", see Column 5 Lines 43-47) for expressing

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contents of the absorbent material. The Appellant contends that Martin cannot provide the claimed device because Martin requires that the foam material must be removed from the cover for use on a surface. In response to appellant's argument that Martin's pad is does not require the foam material inserted within the cover for use, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also Column 5 Lines 55-56 that state "the first layer (12) is encased *entirely* within the sleeve. Regarding **claim 4** in that the Appellant contends that Martin is silent in regards to the holes being spaced on one-half inch centers, Column 5 line 46 discloses a hole size of 1/16 of an inch and therefore every eighth hole is one half inch interval from another hole that is eight holes away. Again, the mesh polyester netting has "mesh openings" which are considered "holes" since a hole, defined by *The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2000 by Houghton Mifflin Company.*, is "An opening or perforation." Regarding **claim 5** the Appellant contends that Martin does not and cannot teach an elongate sponge, however Martin does teach an elongate sponge (12; Column 5 Lines 50-56). Examiner does not understand the argument regarding **claim 6** defining the one piece as being at least one rectangular sheet, and that Martin requires at least two, if not more,

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rectangular spaced pieces. Since Martin requires at least two rectangular spaced pieces, that is "at least one". Examiner does not understand the argument regarding **claim 7** in that "Martin's plurality of sheets may have end and side edges, but not the at least one sheet with the edges." Since Martin's plurality of sheets has end and side edges, then it *has at least one sheet* with edges. Examiner does not understand the argument regarding **claim 8** in that "Martin requires end stitches and side stitches to join the top and bottom panels." Claim 8 requires that the pad further comprises "a pocket formed by joints along the side-edges and/or end-edges of the sheet for receiving and holding the absorbent material in the pocket" (a pocket is defined as "A receptacle, cavity, or opening" according to *The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2000 by Houghton Mifflin Company.*) Martin discloses (14) as a sleeve, and therefore Martin clearly states that it comprises a pocket since the side-edge/end edge-joints comprise the stitching or sealing (Column 6 Lines 22-25). Again, the Examiner does not understand the argument regarding **claim 9** in that Martin does not have the edges and side of the at least one sheet being joined. Clearly Column 6 Lines 22-25 states that the side-edges and end-edges are stitched or connected by adhesion, and form joints. The Appellant has not made an argument regarding **claim 18** in view of the 35 USC 102(b) rejection of Martin, so in view of Martin claim 18 will stand or fall in view of claim 1, from which claim 18 depends.

Next, the Appellant argues that Giallourakis does not describe or teach a wringable pad that has an absorbent material enclosed within a cover that has holes for expressing contents of the absorbent material when wringing the pad by twisting along

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the length of the pad in regards to **claim 39**. However, Giallourakis *does* a wringable pad that has an absorbent material (2) enclosed within a cover (see Figures 3 and 4) that has holes (see Figure 5) for expressing contents of the absorbent material when wringing the pad by twisting along the length of the pad. Also, the Appellant contends that the Examiner has failed to show a teaching, suggestion, or inherence anywhere in Giallourakis of plural holes in the cover that encloses the pad and helps express fluids. Claim 39 however does not claim "holes", but "openings". Giallourakis is a loosely knit material and since it is a loosely knit material, exemplified by Figure 5, there is a plurality of openings. Further, in response to appellant's argument that the cover helps express material when wringing the pad, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The Appellant argues that none of the features (which specifically have to do with the openings) of each of the individual **claims 40-47** can exist in Giallourakis because the reference mandates a loosely knit cover material for the entire cover. Again, as stated also above, Giallourakis is a loosely knit material and since it is a loosely knit material, exemplified by Figure 5, there is a plurality of openings. Regarding the individual **claims 48-56**, which claim different aspects of the structure of the connections that join the cover, Giallourakis does not

teach the claimed connections being along the different sides defined in claims 48-56 for the elongated wringable pad of the invention. Giallourakis *does* teach the claimed connections being along the different sides defined in claims 48-56 for the elongated wringable pad of the invention. The cover further comprises connections that are seams (Figure 2 (12), (14), (18)) that can be turned inside out as shown in Figure 3 to have inside seams for a smooth outer surface. The connections are on both or either side portion, the top and bottom portions, and one end portion (Figures 2 and 3). The other end portion "seam" comprises of an elastic member (Figure 4 (13)) that joins the end portion to the side portion, top portion, and bottom portion and forms a smooth outer surface.

Next, the Appellant does not apply an argument in view Sewell to **claim 1**, however the Appellant discusses the structure of Sewell and may be trying to assert how the structure of Sewell differs from what is found in claim 1. However, Sewell discloses a combination sponge and chamois that is an elongated (Figures 1, 2, or 3) wringable pad that has a chamois cover (Figure 1 (3), Figure 2 (7), and Figure 3 (13)), at least one rectangular piece forming the cover (Figures 1-3), plural holes in the piece (Figure 1 (4); Figure 2 (11); Figure 3 (15)), the pad of a sufficient length to wring, an artificial sponge (which would include poly) (Figure 1 (2); Figure 2 (6); Figure 3 (12)). It would have been obvious to one of ordinary skill in the art to modify the width or length of Sewell to provide the user with a sponge that can be gripped easily or to ergonomically clean narrow areas. In regards to individual **claims 2-3** the Appellant states that neither "die-cut" holes nor "punched" holes are taught or suggested by

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Sewell. It is noted that "die-cut" or "punched" applies to specific processes of creating holes, and therefore both claims 2 and 3 are considered product-by-process claims and Sewell includes "holes". "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). See also MPEP 2113. In regards to **claim 5** Sewell does not teach nor suggest an elongated wringable pad having a cover enclosing the elongated poly sponge. Sewell *does* teach an elongated wringable pad having a cover enclosing the elongated poly sponge. In Figure 1 the chamois cover (3) encloses the artificial sponge (2) and in Figure 3 the chamois cover (13) encloses the sponge (12). In respect to **claim 6**, the Appellant contends that Sewell anchors two blocks of sponges with one block covered with material such as chamois skin and folded under the second block before anchoring the second block to the first block. Also, the Appellant contends that has nothing to do with the elongated wringable pad with its rectangular sheet forming the cover enclosing the sponge. Examiner does not understand the argument that the sponge and chamois combination of Sewell "has nothing to do with the elongated wringable pad with its rectangular sheet forming the cover enclosing the sponge". The device of Sewell is wringable, has a rectangular sheet forming a cover enclosing a sponge. **Claims 7-9 and 17** each individually claim structure regarding the joints, side-

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edges, and the chamois material forming the cover. Nothing in Sewell teaches nor suggests sewing the side-edges/end-edges of the sheet and receiving the sponge within the cover. However, in the embodiment shown in Figure 3, Sewell provides the teaching of sewing the side-edges/end-edges of the sheet and receiving the sponge within the cover. See Column 2 Lines 22-23. **Claims 18-19** each individually claim structure regarding plural chamois pieces. The Appellant contends that Sewell does not teach nor suggest plural pieces forming the cover, that the plural pieces are chamois or man-made chamois cloth. However, Sewell teaches plural pieces forming the cover (see Figure 3; Column 2 Lines 18-20), that the plural pieces are chamois or man-made chamois cloth (Column 1 Lines 19, 21-23, 46-48; Column 2 Lines 19-20.) The limitation that the chamois must be "man-made" is considered to be a product-by-process claim. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). See also MPEP 2113. In general regarding Sewell, the Appellant contends that Nothing in Sewell teaches or suggests a pad with a cover enclosing an absorbent material with the cover having holes for expressing contents from the pad and that the Examiner picks and chooses different features from different embodiments in Sewell to negate the claimed elements even though Sewell neither describes, suggests, teaches nor

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inherently provides these claimed features. However, Sewell *does* teach a pad with a cover (3 or 13) enclosing an absorbent material (2) with the cover having holes or openings (4 or 15) for expressing contents from the pad. Also, by discussing all three embodiments of Sewell, the Examiner demonstrates and points out all of the features of all three embodiments (Figure 1, 2, or 3) that meet the Appellant's claimed invention. Figure 3 is the embodiment that shows the cover *entirely* enclosing the absorbent pad, however all the embodiments meet the claimed invention.

Further, the Appellant contends that Giallourakis does not teach nor suggest an elongated wringable pad comprising an absorbent material, a cover enclosing the absorbent material, the cover comprising first and second elongated opposite side portions disposed between top and bottom elongated portions, and first and second opposite end portions disposed between the top and bottom elongated portions and between the first and second elongated side portions, the absorbent material having a complementary shape for fitting within the cover. As mentioned above, Giallourakis *does* teach an elongated wringable pad comprising an absorbent material, a cover enclosing the absorbent material, the cover comprising first and second elongated opposite side portions disposed between top and bottom elongated portions, and first and second opposite end portions disposed between the top and bottom elongated portions and between the first and second elongated side portions, the absorbent material having a complementary shape for fitting within the cover. Also, the Appellant contends that totally absent from Giallourakis is the cover having a plurality of openings for wringing out contents of the pad by twisting along the length of the pad. Thus, the

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reference cannot anticipate nor render obvious the claimed invention. Again, as mentioned above, Giallourakis teaches a cover (8) having a plurality of openings (see specifically Figure 5) for wringing out contents of the pad by twisting along the length of the pad. Regarding **claim 5** the Appellant contends that Giallourakis does not and cannot teach an elongate sponge. However, clearly Giallourakis includes an elongate poly sponge (2; Column 2 Lines 12-13). **Claims 6-10** each individually claim portions of the structure of the clover and the Appellant's contend that Giallourakis does not teach nor suggest the wringable elongated pad with a cover enclosing an absorbent material and the cover having edges joined by stitches. However, Giallourakis *does* teach a wringable pad with a cover enclosing an absorbent material pad and the cover having edges joined by stitches. Even though Figure 4 exhibits that Giallourakis has an open-mouthed cover, the cover still encloses the absorbent material. Enclose is defined as "to contain, especially so as to envelop or shelter" according to *"The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2000 by Houghton Mifflin Company."* As stated above, the edges are joined by stitches. **Claims 11 and 13-14** each individually claim folding geometry/structure of the at least one rectangular sheet. On the contrary, Giallourakis does in fact disclose at least one rectangular sheet has folds medially between the end edges about an axis forming a pocket having equal halves joined along the side edges (Figures 1A and 2A) Giallourakis discloses that an at least one rectangular sheet that has opposite end-edges and side-edges has a fold between the end edges about a medial axis forming a pocket having the adjacent edges joined to each other (Column 3 Lines 10-13, Lines

27-31; Figures 1 A and 2A). **Claims 18, 22, and 23** each individually features of the plural pieces that form a cover. The Appellant argues that Giallourakis does not render obvious plural pieces forming the cover that are rectangular because these claimed features do not relate to elongated wringable pads. In response to appellant's argument that there comprises a plural or four pieces forming the cover that are rectangular because these claimed features do not relate to elongated wringable pads, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Further, the plural pieces are at least four rectangular pieces (Column 3 Lines 35-40 disclose that each of two sheets may have a double layer of material, which is a total of four sheets). Again, in regards to **Claim 27-28**, which individually claim the four pieces connected by seams, the Appellant contends that Giallourakis does not have the plural pieces of the cover as claimed. The Examiner respectfully disagrees, in that the plural pieces are at least four rectangular pieces (Column 3 Lines 35-40 disclose that each of two sheets may have a double layer of material, which is a total of four sheets). In respect to **claim 29** the Appellant contends that Giallourakis does not teach or suggest the plurality of pieces and therefore cannot have the stitches and alignments. Again however, the plural pieces are at least four rectangular pieces (Column 3 Lines 35-40 disclose that each of two sheets may have a double layer of material, which is a total of

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four sheets). **Claims 30-32** individually claim structure regarding the stitches seams that form a pocket structure. The Appellant contends that Giallourakis does not teach nor suggest the claimed wringable elongated pad with the defined seams. The Examiner respectfully disagrees, as mentioned above Giallourakis does in fact teach the wringable elongated pad, and includes defined seams (including 9 and 11). In respect to **claim 33** the Appellant argues that Giallourakis does not teach or suggest that the absorbent material is an elongated poly sponge. Again, Giallourakis *does* in fact include that that absorbent material (2) is an elongated poly sponge (Column 2 Lines 12-13; see Figures). **Claims 34-36** individually claim that the at least four pieces have central connections or have inward facing seams. In respect to these claims, the Appellant contends that Giallourakis does not have plural pieces or central connections. However, Giallourakis discloses that an at least one rectangular sheet that has opposite end-edges and side-edges has a fold between the end edges about a *medial axis* forming a central connection pocket having the adjacent edges joined to each other (Column 3 Lines 10-13, Lines 27-31; Figures 1 A and 2A). Further, in response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the features upon which appellant relies (i.e., central connections) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In regards to **claim 37**, the Appellant argues that Giallourakis requires an opening to remove the sponge from the mesh cover. Further, in response to appellant's argument

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that the references fail to show certain features of appellant's invention, it is noted that the features upon which appellant relies (i.e., does not have an opening) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Again, "enclose" is defined as "to contain, especially so as to envelop or shelter" according to "*The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2000 by Houghton Mifflin Company.*" The edges are joined together by "13" to prevent the absorbent material from slipping out of the pocket. With respect to **claim 38**, the Appellant argues that Giallourakis does not include that at least one of the edges joined together has an outward facing seam. The Examiner respectfully disagrees in that Figure 2 of Giallourakis includes outward facing seams. **Claims 57 and 58** require a length(s) and a width(s) of the pad or portions of the sides of the pads are at least three times greater than the widths. The Appellant contends that Giallourakis does not teach or suggest this feature. As mentioned above, it would have been obvious to one of ordinary skill in the art to modify the width or length of Giallourakis to provide the user with a sponge that can be gripped easily or to ergonomically clean narrow areas. Also, the Appellant argues that the examiner has used the claimed invention as a springboard to hold that unrelated elements in the references actually teach or suggest the claimed features. However, that hindsight construction cannot justify an obviousness holding unless there is a teaching or suggestion within the reference itself. In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper

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hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Next, in respect to **claim 12** as rejected under 35 USC 103(a) to Giallourakis, the Appellant contends that Giallourakis does not teach nor suggest the features of claim 12 which adds to claim 7 that the rectangular sheet that forms the encasing has a fold between the side edges so that the sheet is folded about an axis and joined at the edges to form the encasing for receiving and enclosing the sponge. Giallourakis *does* teach the features that the rectangular sheet that forms the encasing has a fold between the side edges so that the sheet is folded about an axis (5) and joined at the edges to form the encasing (Column 3 Lines 30-31).

Next, in respect to **claim 15** as rejected under 35 USC 103(a) to Martin, the Appellant contends that Martin does not teach or suggest a cover having a length of about 37 $\frac{3}{4}$ " and a width of 6 $\frac{1}{4}$ ". Martin et al. disclose all elements above including a teaching that the device may be used with an additional holder to be further elongated in order to clean a user's back. With this use, the length of the cover could be *about* 37 $\frac{1}{4}$ " and the width is *about* 6 $\frac{1}{4}$ " since those are suitable dimensions for cleaning a human back. Therefore, it would have been obvious for one of ordinary skill in the art to modify Martin et al. so that the cover has a length of about 37 $\frac{1}{4}$ " and the width is about

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6 ¼" as to be *an appropriate dimension for specific cleaning purposes*, such as a human back.

Next, in respect to **claim 16** as rejected under 35 USC 103(a) in view of Sewell or Giallourakis. Claim 16 specifies a certain length and width for the cover, and the Appellants arguments in view of Sewell do not apply to a length or width of the cover, but state that Sewell does not teach or suggest a pad with a cover enclosing an absorbent material with the cover having holes for expressing contents from the pad, in which the cover is sheep-skin chamois. As mentioned above in this document, Sewell does teach a pad with a cover enclosing an absorbent material with the cover having holes for expressing contents from the pad. In regards to the chamois, it would have been obvious to one of ordinary skill at the time of the invention was made to use sheep-skin chamois as a specific chamois cover material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering choice. In re Leshin, 125 USPQ 416. Claim 16 rejected in view of Giallourakis, the Appellant argues that "The only suggestion for the examiner's combination of the isolated teachings of the applied references improperly stems from appellant's disclosure and not from the applied prior art." (Ex parte Levengood, 28 USPQ2d 1300, 1301). In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the

time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It would have been obvious for one of ordinary skill in the art to modify Sewell or Giallourakis so that the cover has dimensions that the length of the cover is about eighteen and three-quarter inches and a width is about twelve and one-half inches as to be an appropriate dimension for specific cleaning purposes.

In regards to **claim 20** which has been rejected under 35 USC 103(a) in view of Sewell, the Appellant contends that Sewell does not comprise a cover made of sheep-skin chamois and that it is impermissible to use an appellant's claim as a springboard for hunting through the prior art for the claimed elements. Sewell is made from chamois, although Sewell does not state a specific type of Chamois. It would have been obvious to one of ordinary skill at the time of the invention was made to use sheep-skin chamois as a specific chamois cover material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering choice. In *re* Leshin, 125 USPQ 416. In response to appellant's argument that it is impermissible to use an appellant's claim as a springboard for hunting through the prior art for the claimed elements and for combining the found elements as claimed in the application, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the

test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Claims 24-25 have been rejected under 35 USC 103(a) over Giallourakis in view of Hale. First, the Appellant contends that Giallourakis teaches away from the claimed invention and therefore any further combination with other references would also lead away from the present claims. However, it is unclear to the Examiner as to how Giallourakis teaches away from the claimed invention. Giallourakis discloses all elements discussed previously. Second, the Appellant contends that Hale has nothing to do with the claimed invention that provides a cover having lengths much greater than a width. The Examiner respectfully disagrees in that Hale provides a teaching that elaborates a more specific dimension for a cleaning object that is hand held. Since Giallourakis is a hand held cleaning and polishing device, it would have been obvious for one of ordinary skill in the art to modify the size of the pad disclosed by Giallourakis and to use pieces of *about* 9 ½" in length and *about* 6 ¼" in width as Hale teaches to make the pad an appropriate and ergonomic size to be hand held. Next, the Appellant contends that there is no teaching or suggestion to adapt the Giallourakis removable sponge within the Hale foldable sleeve and arrive at the claimed invention. In deciding that a novel combination would have been obvious, there must be supporting teaching the prior art. Hale discloses a hand-sized controlled-fold cleaning sleeve that provides the teaching for a hand held wiping or cleaning device, the approximate size required would be 4 inches wide by 9 inches long (Column 3 Lines 27-32). It would have been obvious to one of ordinary skill in the art to modify the size of the pad disclosed by

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Giallourakis and to use pieces of *about* 9 ½" in length and *about* 6 ¼" in width as Hale teaches to make the pad an appropriate and ergonomic size to be hand held. In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hale discloses a hand-sized controlled-fold cleaning sleeve that provides the teaching for a hand held wiping or cleaning device, the approximate size required would be 4 inches wide by 9 inches long (Column 3 Lines 27-32).

Claim 26 has been rejected under 35 USC 103(a) over Giallourakis in view of Sewell. First, the Appellant contends that Giallourakis and Sewell teach away from the claimed invention. Therefore, any further combination with other references would also lead away from the present claims. However, it is unclear to the examiner as to how Giallourakis and Sewell teach away from the claimed invention. Giallourakis and Sewell disclose all elements discussed previously. Secondly, the Appellant contends that there is no showing as to where there is a motivation or a suggestion within the references to effect a combination as proposed by the Examiner. Hindsight reconstruction using the present invention as a guide cannot form a sound basis for an obviousness rejection. In response to appellant's argument that the examiner's

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conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


LCC

Laura C. Cole
September 15, 2004

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